

Attorney Docket No. 05725.1038
Application No. 10/088,636

REMARKS

I. Status of claims

Claims 1-19 have been cancelled without prejudice or disclaimer. New claims 20-49 have been added to place the claims in better conformity with U.S. patent practice. Support for new claims 20-49 can be found in the specification as filed as original claims 1-19. Therefore, no new matter has been added by these amendments.

II. Objection to claims

Claims 4-16 are objected to under 37 C.F.R. § 1.75(c) for improper dependency of a multiple dependent claim from another multiple dependent claim. (*Office Action* at p. 2.)

Claims 4-16 have been cancelled and rewritten as claims 26-46 to remove the multiple dependencies and to place the claims in conformity with U.S. practice. Accordingly, withdrawal of this objection is respectfully requested.¹

III. Rejection under 35 U.S.C. §§ 101 and 112, second paragraph

Claims 17-19 are rejected under 35 U.S.C. § 101 for reciting a use without setting forth any steps involved in an process, and under § 112, second paragraph as being indefinite. (*Office Action* at pp. 2-3.)

Claims 17-19 have been rewritten as claims 47-49. Independent claims 47 and 49 now recite the step of "applying to hair." Accordingly, it is believed that claims 47-49 satisfy 35 U.S.C. §§ 101 and 112. Withdrawal of this rejection is respectfully requested.

¹ The Examiner also expressed concerns with respect to claims 2 and 3. These concerns were addressed by the cancellation of these claims, and the presentation of new claims 22-25.

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IV. Rejection under 35 U.S.C. § 103

Claims 1-3 are rejected as being unpatentable over U.S. Patent No. 5,441,728 to Tsaur et al. ("Tsaur") in view of U.S. Patent No. 5,874,091 to Grollier ("Grollier"). (*Office Action* at pp. 3-4.) Applicant respectfully traverses this rejection.

The Examiner cites Tsaur for teaching an aqueous hair composition comprising a latex of water-insoluble polymeric particles having an average particle size of 3 micron or less and a glass transition temperature between 250K (-23°C) and 300 K (27°C). (*Id.*) The Examiner admits that Tsaur is silent on the thickness of polymer particles. (*Id.*) To remedy this deficiency, the Examiner cites Grollier for teaching a composition comprising polymeric particles having a size ranging from 500 nm to 25,000 nm and a thickness greater than 10 nm. (*Id.* at p. 4.) According to the Examiner, it would have been obvious to "modify the composition of Tsaur ... by optimizing the thickness of the polymeric particle ... as taught by Grollier ... with a reasonable expectation of success." (*Id.*)

In making a rejection under 35 U.S.C. § 103, the Examiner must first show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. M.P.E.P. § 2143.

Applicant respectfully submits that the Examiner has not met this burden. Tsaur describes an aqueous hairspray composition comprising a water-soluble polymer and a latex of water-insoluble polymeric particles. (*Tsaur* at col. 2, lines 50-63.) The latex and water-soluble polymer interact "to provide an overall superior hairsetting composition." (*Id.* at col. 3, lines 13-15.) Additionally, the composition should be sprayed "as relatively

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uniform particles.” (*Id.* at col. 2, lines 42-44.) To achieve these objectives, Tsaur guides one of ordinary skill in the art to provide a water soluble polymer and water-insoluble polymer particles, and to manipulate the solution viscosity and concentration of the water soluble polymer to achieve an interaction between the water-soluble polymer and water-insoluble polymeric particles. (*Id.* at col. 6-13.) With regards to particle size, Tsaur simply teaches that the water-insoluble polymeric particles should have an average particle size of no more than 3 microns, and preferably no more than 1 micron. (*Id.* at 4, lines 34-38.)

Grollier describes a cosmetic composition, based on lipid vesicles, that include melanin pigments for the protection of keratinous substances, such as skin and hair, against ultraviolet radiation. (*Grollier* at col. 1, lines 7-13.) In one embodiment, the melanin pigments are combined with at least one particulate filler. (*Id.* at col. 4, lines 21-23.) The particulate filler can be an inert mineral filler (col. 4, lines 34-41), a polymer filler (col. 4, line 42 to col. 5, line 46), silicone powders (col. 5, lines 47-48), or can be chosen from organic or mineral particles having a lamellar structure (col. 5, line 49 to col. 6, line 13). The compositions can be in the form of lotions (e.g., Example 3), creams (e.g., Examples 2 and 4-8), or even as a foundation, mascara, eye shadow, rouge, or for dyeing of the hair (col. 7, lines 65-67).

Applicant respectfully submits that there is no suggestion to modify the particles of Tsaur as taught by Grollier. It is well-settled law that the prior art “must suggest the desirability of the claimed invention.” (M.P.E.P. § 2143.01.) Grollier merely teaches as only one embodiment among many that lamellar particles can be used as a particulate filler for its composition comprising melanin pigments. Thus, statistically, the combined

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teachings of Tsaur and Grollier, would favor using non-lamellar type particles. The Examiner, however, has simply picked one embodiment from the combined teachings of Tsaur and Grollier to use lamellar particles. Yet, the Examiner has done so without a suggestion that lamellar particles would benefit a hairspray composition when compared to polymer particles having a generally uniform particle size.

Moreover, Applicant respectfully disagrees that combining the teachings of Tsaur and Grollier could be made with a reasonable expectation of success, as asserted by the Examiner. As discussed above, Tsaur's composition comprises a water-soluble polymer having specific viscosity and glass transition properties, and a latex of water-insoluble polymeric particles that interact with each other to provide a desired hairsetting effect. There is no reasonable expectation of success that incorporating Grollier's lamellar particles as the water-insoluble polymeric particle in Tsaur would result in this desired interaction with the water-soluble polymer.

Additionally, Tsaur teaches that the composition should be sprayed as relatively uniform particles. However, none of the references provide a reasonable expectation of success that modifying the water-insoluble particles of Tsaur to a lamellar structure would result in a spray of relatively uniform particles.

Accordingly, Applicant respectfully submits that the Examiner has failed to provide a prima facie case of obviousness. Withdrawal of this rejection is respectfully requested.

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V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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